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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/629,909      | 07/31/2000  | Douglas B. Quine     | F-176               | 5067             |

919 7590 09/08/2004

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EXAMINER

BAYARD, DJENANE M

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2141

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/629,909

Applicant(s)

QUINE, DOUGLAS B.

Examiner

Djenane M Bayard

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Argument***

1. This is in response to communication filed on 6/23/04 in which claims 10-22 are pending. Applicant's argument has been considered and the finality has been withdrawn. In addition a new ground of rejection is provided below.
2. Applicant argues that the U.S. Patent No. 6,438,583 to McDowell in view of U.S. Patent No. 6,075,844 to Goldberg et al fails to teach "the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the senders address". Therefore, a new ground of rejection was introduced in order to teach the above limitation. U.S. Patent No. 6,438,583 to McDowell teaches "bouncing undeliverable e-mails back to the sending computer."

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 10, 13-14, 17, 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,438,583 to McDowell et al.

Art Unit: 2141

a. In regard to claim 10, McDowell et al teaches a method for transmitting an e-mail message intended for a non-preferred e-mail address to a preferred e-mail address (See col. 1, lines 46-48), the method comprising the steps of: receiving the e-mail message at a second address (See col. 8, line 33); parsing the non-preferred e-mail address from the e-mail message at the second address and determining if there is a preferred e-mail address associated with the non-preferred e-mail address; and sending the e-mail message from the second address to the preferred e-mail address (See col. 8 lines 9-10 and lines 34-43). Furthermore, McDowell et al teaches wherein the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the sender address (See col. 6, lines 31-47).

b. In regard to claim 13, McDowell et al teaches that the parsing step further comprises the step of comparing the non-preferred e-mail address to a lookup table to determine if the non-preferred e-mail address is contained in the look-up table (See col. 8, lines 9-10).

c. As per claim 14, McDowell et al teaches a method for transmitting an e-mail message comprising the steps of: receiving an e-mail message at a second address (See col. 1, lines 46-48), the e-mail message including non-preferred e-mail address data associated with a desired recipient; parsing the e-mail message to obtain the non-preferred e-mail address data from the e-mail message; determining a preferred e-mail address from the non-preferred e-mail address data; and sending the e-mail message from the second address to the preferred e-mail address when the preferred e-mail address has been established (See col. 8 lines 9-10 and lines 34-

Art Unit: 2141

43). Furthermore, McDowell et al teaches wherein the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the sender address.

d. As per claim 17, McDowell et al teaches a method for transmitting an e-mail message that has been sent from a sender address to a previously-known recipient e-mail address and rejected at the previously-known recipient e-mail address, the method comprising the steps of: receiving the rejected e-mail message at a second address; determining a preferred recipient e-mail address from the rejected e-mail message; and sending the e-mail message from the second address to the preferred e-mail address when the preferred e-mail address has been determined (See col. 8 lines 9-10 and lines 34-43). Furthermore, McDowell et al teaches wherein the e-mail message having been transmitted back to the sender address (See col. 6, lines 31-47)

e. As per claim 20, McDowell et al teaches the step of comparing the previously-known recipient e-mail address to look-up table to determine if the previously-known recipient e-mail address is contained in the look-up table (See col. 8, lines 9-10).

f. In regard to claim 21, McDowell et al. teaches a method for transmitting an e-mail message that was sent from sender address to a previously-known recipient e-mail address that is associated with a first service provider (See col. 1, lines 50-53), and rejected at the previously-known recipient e-mail address, the method comprising the steps of: receiving the rejected e-mail message at a second address; determining a preferred recipient e-mail address, that is associated with a second service provider from the rejected e-mail message; and sending the e-mail message

Art Unit: 2141

from the second address to the preferred e-mail address when the preferred e-mail address has been determined (See col. 8, lines 7-11) . Furthermore, McDowell et al teaches wherein the e-mail message having been transmitted back to the sender address. (See col. 6, lines 31-47).

g. In regard to claim 22, McDowell et al. teaches a method for transmitting an e-mail message that has been sent from a sender address to a second address, the e-mail message including non-preferred e-mail address data associated with a first service provider and a desired recipient (See col. 1, lines 50-53) comprising the steps of: receiving the e-mail message at the second address; parsing the e-mail message to obtain the non-preferred e-mail address data from the e-mail message; determining a preferred e-mail address, that is associated with a second service provider, from the non-preferred e-mail address data; and sending the e-mail message from the second address to the preferred e-mail address when the preferred e-mail address has been established (See col. 8, lines 7-11 and lines 34-43) .Furthermore, McDowell et al teaches wherein the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the sender address (See col. 6, lines 31-47).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11,15,18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. No. 6,438,583 to McDowell in view of U.S. Patent No. 6014688 to Venkatraman et al.

a. In regard to claims 11,15 and 18, McDowell et al discloses the claimed invention as described above. McDowell et al teaches the step of sending an e-mail message to the sender address from the second address (See col. 12, lines 16-17), however McDowell et al does not explicitly teaches that the e-mail indicates that the e-mail has been sent to the preferred e-mail address.

Venkatraman et al teaches the step of sending an e-mail message to the sender address to indicate that the e-mail has been sent to the preferred e-mail address (See col. 2, lines 35-36).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the step of sending an e-mail message to the sender address from the second address indicating that the e-mail has been sent to the preferred e-mail address as taught by Venkatraman et al in the method of McDowell et al so because the sender of the e-mail message needs to verify that the e-mail message was received by the preferred e-mail address (See col. 1, lines 48-50).

6. Claims 12, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. No. 6,438,583 to McDowell in view of U.S. Patent No. 6,405,243 B1 to Nielsen.



Art Unit: 2141

a. In regard to claims 12, 16, and 19, McDowell et al discloses the claimed invention as described above. McDowell et al teaches the step of sending an e-mail message to the sender address from the second address (See col. 12, lines 16-17), however McDowell fails to disclose that the step of sending an e-mail message to a sender address from the second address indicating that the e-mail message was not forwarded to the preferred e-mail address if the preferred e-mail address is not determined.

Nielsen teaches the that the step of sending an e-mail message to a sender address from the second address indicating that the e-mail message was not forwarded to the preferred e-mail address if the preferred e-mail address is not determined (See col. 4, lines 66-67 and col. 5 lines 1-5)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the step of sending an e-mail message to a sender address from the second address indicating that the e-mail message was not forwarded to the preferred e-mail address if the preferred e-mail address is not determined as taught by Nielsen in the method of McDowell et al in order to update the sender about whether or not the second address has an updated email address for the recipient (See col. 6, lines 41-42).

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M Bayard whose telephone number is (703) 305-6606. The examiner can normally be reached on 7:00 AM-4:30 PM.

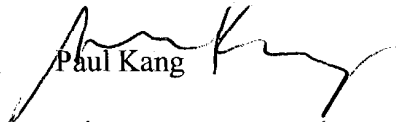
Art Unit: 2141

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard

Patent Examiner

  
Paul Kang  
Primary Patent Examiner